

Docket No.: PF-0069-1 CON

REMARKS

This Supplemental Response is responsive to the request made by Examiner Mertz during the telephonic Examiner's Interview held on January 6, 2004. The Examiner had suggested that if we provided a new set of claims that she proposed and provided corroborative evidence that this claimed polypeptide has chemotactic activity, she would withdraw all rejections to the claims and allow this case. The Examiner is thanked for her time.

I. Utility rejection under 35 U.S.C. § 101

Claims 3-7, 9, 10, 12, 13, 46, and 57-59 were rejected under 35 U.S.C. § 101, based on the allegation that the claimed invention is not supported by either a specific, substantial, and credible asserted utility or a well established utility (Office Action, September 5, 2003; page 3). This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

In addition, Applicants submit corroborative evidence showing that the SEQ ID NO:1 polypeptide is a monocyte chemotactic proprotein, now referred to as MCP-2. An alignment performed by BLAST analysis shows that the sequences of SEQ ID NO:1 and MCP-2 are 99% identical (Attachment 1). The article by Van Coillie et al. (Biochem. 37:12672-12680, 1998 (Attachment 2) indicates that MCP-2 has chemotactic activity. Accordingly, this is yet another powerful demonstration of the effectiveness of sequence homology in the assignment of biological function.

II. Utility/enablement rejection under 35 U.S.C. § 112, first paragraph

Claims 3-7, 9, 10, 12, 13, 46, and 57-59 were rejected under 35 U.S.C. § 112, first paragraph, based on the alleged lack of utility under 35 U.S.C. § 101.

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The rejection set forth in the Office Action is based on the assertions discussed above, i.e., that the claimed invention lacks patentable utility. To the extent that the rejection under 35 U.S.C. § 112, first paragraph, is based on the improper allegation of lack of patentable utility under 35 U.S.C. § 101, it fails for the same reasons.

III. Written description rejections under 35 U.S.C. § 112, first paragraph

Claims 3, 6, 7, 9, 12, 13, 46, and 59 were rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which allegedly fails to reasonably convey to one of skill in the art that the Applicants had possession of the claimed invention at the time the application was filed. This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

IV. Enablement rejections under 35 U.S.C. § 112, first paragraph

Claims 3, 6, 7, 9, 12, 13, and 46 were rejected under 35 U.S.C. § 112, first paragraph, based on the allegation that the specification does not describe the subject matter of the invention in such a way as to enable one of skill in the art to use the claimed variants and fragments. This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

V. Rejection of claim 3 under 35 U.S.C. § 112, second paragraph

Claim 3 was rejected under 35 U.S.C. § 112, second paragraph, based on the allegation that the recitation of the phrase "chemotactic activity" is indefinite. The Office Action asserts that "it is

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unclear for which type of cells the polypeptide encoded by the claimed polynucleotide, is chemotactic" (Office Action, September 5, 2003; page 17). This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

VI. Rejection of claims 3, 12, and 13 under 35 U.S.C. § 112, second paragraph

Claims 3, 12, and 13 were rejected under 35 U.S.C. § 112, second paragraph, based on the allegation that the recitation of "naturally occurring" is indefinite. The Office Action asserts that "[i]t is unclear whether this term imposes a required limitation on the claim, such that it only encompasses, for example, polynucleotides amplified from human cDNA, or only sequences produced by digestion with restriction enzymes of DNA isolated from tissue which contains polynucleotides encoding the polypeptide, or if the claim encompasses all polynucleotide sequences that encode the polypeptide" (Office Action, September 5, 2003; page 17). This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

VII. Rejection of claim 58 under 35 U.S.C. § 112, second paragraph

Claim 58 was rejected under 35 U.S.C. § 112, second paragraph, because it recites "a polynucleotide comprising the amino acid sequence of SEQ ID NO:2" (Office Action, September 5, 2003; page 17). This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, except claim 58 has been canceled and substituted with new claim 65.

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VIII. Rejection of claims 6, 7, 9, 46, and 59 under 35 U.S.C. § 112, second paragraph

Claims 6, 7, 9, 46, and 59 were rejected under 35 U.S.C. § 112, second paragraph, because they are allegedly “dependent on the above rejected claims for their limitations” (Office Action, September 5, 2003; page 17). This rejection is traversed.

Applicants reiterate that same arguments presented in the earlier filed Response mailed December 5, 2003 to this Office Action, but which are applied to the new claim set.

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CONCLUSION

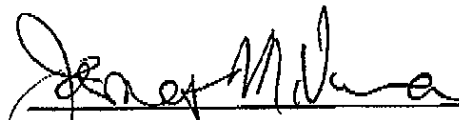
In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding objections/rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

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Attachments:

1. Results of BLAST search
2. Van Coillie et al. Biochem Article with NCBI datasheet